

Serial No. 09/347,427
Reply to Office Action dated June 3, 2004

Docket No. MEMS-0254-US

REMARKS/ARGUMENTS

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the following remarks. Claims 3-5, 7-9 and 12-24 are pending in the application. Claims 5, 7-9, 15 and 16 are withdrawn from consideration.

35 U.S.C. § 102 & 103 Rejections

Claims 3, 4, 12-14, 17-21, 23 and 24 were rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Hambright (U.S. Patent No. 5,938,989) in view of Maus et al. (U.S. Patent No. 4,828,769 "Maus '760"). Claim 22 was rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Hambright (U.S. Patent No. 5,938,989) in view of Maus et al. (U.S. Patent No. 4,828,769 "Maus '760") and in further view of Maus et al. (U.S. Patent No. 5,512,221 "Maus '221"). Applicant respectfully traverses each of these rejections for at least the following reasons.

Interview

At the outset, Applicant's representative thanks the Examiner for the courtesies extended during the interview conducted on September 2, 2004. As discussed in the interview, Applicant's representative discussed that the combinations as alleged by the Examiner are not properly combinable and even if combined would not yield the claimed invention. Unfortunately no agreement was reached on this matter. Further, details in accordance with the substance of the interview arguments are presented below in response to the Examiner's Response to Arguments in the outstanding Office Action.

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Reply to Response to Arguments

Since the Examiner has maintained the prior rejections and has provided arguments in support of this position, Applicant will address the Examiner's response first.

The Examiner alleges in his response that etched parts of Hambright constitutes "the mold with a plurality of optical patterns" and that the "mold pins defining the mold cavity are shown as inserts 5a and 5b..." of Maus '769. Further, the Examiner alleges that the additional features not shown in Hambright are taught by Maus '769 and would be necessary in Hambright to practice the injection molding process that Hambright is directed to. Finally, the Examiner alleges that the combination of these references yield Applicant's claimed combinations. Applicant respectfully disagrees.

In regard to inserts 5a and 5b functioning as the mold pins defining the mold cavities, Applicant notes that these inserts 5a and 5b define the mold cavity, but that these inserts are located on the first and second mold pieces. In contrast Applicant's claimed combination has the mold pins in only in the first mold unit.

Further, regarding the alleged combination in of Hambright in view of Maus '769, Applicant does not concede that these references would be combined by one skilled in the art. However, even if they were combined the teachings of Maus '769 used to modify Hambright would not yield Applicant's claimed combinations. As noted during the interview, Hambright has teaches a plurality of optical patterns being formed in a disk configuration to take advantage of the availability of optical disk manufacturing equipment. The patters 32 of Hambright are not separately molded in a defined cavity as is performed in the Maus '769 reference. Applying the teachings of Maus '769 to the Hambright invention at best would yield a mold apparatus that had mold element 16

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replaced with an insert and a clamp and mold mechanism of Maus '769. There are no plurality of "mold cavities" in Hambright and there is no teaching or suggestion to modify the mold of Hambright into a multi-cavity mold.

As stated in MPEP § 2143.01, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As discussed above, if the Maus '769 is applied as the Examiner alleges, the "principle of operation" of Hambright (i.e., making a plurality of optical elements on a common disk and cutting them out later) would be significantly changed. Accordingly, Applicant respectfully submits that the teachings of the references are not sufficient to render the claims prima facie obvious.

During the interview the Examiner also alleged that the teachings of Hambright could alternatively be applied to Maus '769, to yield Applicant's claimed combinations. However, as discussed during the interview, Applicant respectfully disagrees. Applicant respectfully submits that if Maus '769 was modified using the teachings of Hambright (which Applicant's once again believe one skilled in the art would not do) the resulting combination would not teach Applicant's claimed combinations. As discussed, if the etched optical patterns taught in Hambright would be applied to the teachings of Maus '769, at best the combination would yield an etched surface of insert 5a. There is no teaching or suggestion in either reference to incorporate the disk of Hambright into

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the mold system of Maus '769 and make all the necessary modifications to element 14 of Hambright to allow for the patterns to align, seal, have only the bottom portion insert 5b be adjusted to define the mold cavity etc., to yield individual patterned optical elements.

Accordingly, as noted above, the teachings of Hambright and Maus '769, or any combination of the two documents do not render the Applicant's claimed combinations obvious, as suggested by the Office Action. Further, Applicant submits that one of ordinary skill in the art would not have been motivated to modify the systems of Hambright and Maus '769 to arrive at Applicant's claimed combinations absent impermissible hindsight reference to Applicant's specification.

Summary

Since the Examiner has maintained his rejection of claims 3, 4, 12-14, and 17-24 under 35 U.S.C. § 103 as noted above, Applicant once again traverses these rejections. Applicant expressly maintains the reasons from the prior responses to clearly indicate on the record that Applicant has not conceded any of the previous positions relative the maintained rejections. For brevity, Applicant expressly incorporates the prior arguments presented in the March 11, 2004 response without a literal rendition of those arguments in this response.

For at least the foregoing reasons and the reasons set forth in Applicant's response of March 11, 2004, it is respectfully submitted that claims 3, 12 and 17 are distinguishable over the applied art. The remaining dependent claims are allowable at least by virtue of their dependency on the above-identified independent claims.

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Moreover, these claims recite additional subject matter, which is not suggested by the documents taken either alone or in combination.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 50-3136 and please credit any excess fees to such deposit account.

Respectfully submitted,
KCO Law, PLLC



Mark E. Olds
Registration No. 46,507

P.O. Box 220472
Chantilly, VA 20153-0472
(888) 510-0695

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Attachment(s):